

AMENDMENT UNDER 37 C.F.R. § 1.111
US Appln. No. 09/328,893

REMARKS

Claims 1-10 are all the claims pending in the application. Claims 1-3 and 5-10 stand presently rejected under 35 U.S.C. § 103(a) as being unpatentable over Bennett et al (US Patent No. 5,189,733) in view of Mishra (US Patent No. 6,339,587). Further, claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bennett in view of Mishra and further in view of Finni (US Patent No. 5,941,978). Finally, claim 10 is objected to. By this Amendment, Applicants amend claim 10 for non-substantive reasons.

Claim 1 is directed to a method, wherein a network element is connected to a Synchronous Digital Hierarchy (SDH) network.

The Examiner acknowledges in item 2 of the present Office Action that “Bennett does not disclose a Synchronous Digital Hierarchy network as claimed.” However, the grounds of rejection state that “Mishra discloses a Synchronous Digital Hierarchy network (SDH network 91)”, and cite col. 5, ln. 52, to col. 6, ln. 65, in support of this statement.

The Mishra reference teaches that, in an SDH network, traffic capacity can be booked in advance, on request of the user of the SDH network. It is then necessary to meet this request by allocating a path through the network having the required capacity. Therein, the customer may have specific requirements. For example, two or more independent paths may be required,

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which share no individual links or nodes, to ensure that an individual failure does not result in loss of the entire booked capacity.¹

According to Mishra, there is provided a method of operating a network management system for a telecommunications network in order to satisfy a request for a connection path having a specified capacity between two specified terminations of the network. Therein, the method searches a store of routings and available capacities to identify a connection path to satisfy the request; determines whether a connection path with adequate capacity is present in the store; if no such path is present in the store, tests a model of the network to identify at least one suitable connection path between the requested terminations and adds any suitable connection paths so identified to the store; and, upon identifying a connection path having the requested capacity between the requested terminations, allocates the identified connections so as to satisfy the request.²

Fig. 1 of the Mishra reference shows an SDH network 91 utilized in an exemplary embodiment.

However, there is no teaching or suggestion in col. 5, ln. 52, to col. 6, ln. 65, cited by the Examiner, or in any other part of the Mishra reference, that would have motivated a person skilled in the art to use Mishra's SDH network in a method as claimed in claim 1, which checks, in response to a request for access to one of a plurality of managed objects, whether this

¹ See Mishra reference, col. 2, ln. 29-36

² See Mishra reference, col. 3, ln. 39-56

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requested object is stored in a memory of a network element connected to a Synchronous Digital Hierarchy network; which, if this requested object is not stored in the memory, checks whether there is sufficient memory space to write this object into the memory; which, if there is no sufficient memory space, swaps at least one of the stored objects out of the memory to a database according to at least one predetermined criterion; and which reads the requested object from the database and writes it into the memory.

Instead, col. 5, ln. 52, to col. 6, ln. 65, cited by the Examiner, merely describes various parts of the tiered Synchronous Digital Hierarchy network 91 shown in Fig. 1 (such as nodes, trunk connections, tier rings, add-drop multiplexers, cross-connects); a diagrammatic representation of an STM-1 module shown in Fig. 2; and various parts of a network management system 200, shown in Fig. 3, for managing the Synchronous Digital Hierarchy network 91 shown in Fig. 1.

It is not apparent from these descriptions of the various structures of the Synchronous Digital Hierarchy network 91, the STM-1 module, and the network management system 200, how or why a person skilled in the art would have been motivated to use the Synchronous Digital Hierarchy network 91 in the method claimed in claim 1, which recites the above-mentioned various checking, swapping, reading, and writing steps. The motivation suggested in the grounds of rejection ("it would have been obvious to have used the Synchronous Digital Hierarchy network in Bennett as taught by Mishra because it not only allows transmission at variable bit rates to be carried, but allows individual signals to be added or extracted without demultiplexing other signals multiplexed with it") is taken from Mishra's "Background of the

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Invention" section (specifically: col. 1, ln. 47-51). Col. 1, ln. 47-51, teach that these features mentioned in the motivation suggested by the Examiner are standard for Synchronous Digital Hierarchy networks. However, it is not apparent how, without more, the mere teaching of these standard features of Synchronous Digital Hierarchy networks would have motivated a person skilled in the art to use a Synchronous Digital Hierarchy network in the method of claim 1, which recites the above-mentioned various checking, swapping, reading, and writing steps. No such motivation is suggested in col. 1, ln. 47-51.

For at least these reasons, Applicants submit that independent claim 1 is patentable over the prior art made of record.

Independent claim 7 is directed to a network element, wherein the network element is connected to a Synchronous Digital Hierarchy (SDH) network, and wherein a controller performs the above-mentioned checking, swapping, reading, and writing steps.

Independent claim 9 is directed to Synchronous Digital Hierarchy (SDH) network with network elements, wherein each network element is connected to the Synchronous Digital Hierarchy (SDH) network, and wherein a controller performs the above-mentioned checking, swapping, reading, and writing steps.

Thus, Applicants submit that patentability arguments analogous to those presented in connection with the discussion of the patentability of claim 1 apply to claims 7 and 9 with equal force.

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The dependent claims should be patentable at least by virtue of dependency from their respective independent claims.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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WASHINGTON OFFICE



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PATENT TRADEMARK OFFICE

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APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims are amended as follows:

10. (Twice Amended) The Synchronous Digital Hierarchy (SDH) network as claimed in claim 9, wherein the network elements are at ~~lease~~least one of crossconnects, add-drop multiplexers, and line multiplexers.